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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,569	08/06/2001	Kenichi Sakuma	862.C'2324	7063
5514 7590 01/25/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
RUHL, DENNIS WILLIAM				
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3629				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/921,569

Applicant(s)

SAKUMA ET AL.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 61-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: 7/11/07

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's response of 11/5/07 has been entered. Currently claims 61-71 are pending. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 61-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (6609050) in view of Wong (5432904) and further in view of Morrell (4745602).

For claims 61,63,64,66,67,69,70,71, Li discloses a system and method for administering warranty services and repair services for equipment such as automobiles. Li discloses a *user terminal* 80 that is used to send error code information to a management server. The user terminal 80 is disclosed as being the computer at the

home of a person or a computer at the location of service, see column 3, lines 43-48.

The claimed *failure code transmission unit* is satisfied by the fact that the user terminal 80 has software and hardware that allows data to be sent to the management server regarding the problem that needs to be fixed. Li discloses a management server that has a *storage unit* in the form of databases 93 and 94 (col. 4, lines 26-33). The databases store information about customer owned equipment such as their vehicles. The *check unit* that is adapted to check whether or not certain equipment is under warranty or not is 41. See column 4, lines 26-28 and column 6, lines 49-51. This determination inherently involves the use of the customer database as claimed. The *estimation unit* that can calculate a repair estimate fee is disclosed in column 8, lines 6-23 and figure 23. On the basis of a code, such as "002", the standardized hours for this service are retrieved, which is what the repair estimate is based on. Because the estimate for the repair is disclosed as being generated, and because a repair estimate inherently includes the cost of any parts needed to do the repair, it is inherent that there is a *determination unit* that determines the "price of the equipment" by looking it up in a database as claimed (in a party specifying table). This is a part of the repair estimate process. The *transmission unit* (claims 61-63) that is adapted to transmit certain information to the user via a network is the hardware and software of the system of Li that outputs data to the terminal of a user, such as the person requesting or viewing the estimate data that the system provides. Li necessarily has a data transmission unit (i.e. data ports, a modem, software for data transfer, etc.). To the extent that the language of claim 61 regarding the transmission unit in the apparatus claims defines any

structure, Li satisfies that structure because Li discloses a transmission unit that transmits data such as a repair fee estimate to a user terminal. The transmission unit of Li is fully capable of transmitting the claimed types of information and will transmit whatever kind of data it is requested to send, which satisfies the "adapted to" language of the claims. The kind of data the transmission unit is intended to transmit is not defining any further structure to the claimed system or to the claimed transmission unit, other than the ability to transmit this kind of data. The data is sent over a network as claimed.

Not disclosed is that there is a *determination unit* that determines whether or not a *ratio of the repair fee estimate to the "specified price"* (the price for a new part) is a predetermined value or more (this applies to all independent claims). Not disclosed is the step of transmitting a method of recovering an article to be repaired and a type of method for delivery of the article as claimed. Also not disclosed is the fact that the equipment that is being checked is a printer and that the failure code is received from the printer.

Wong discloses an equipment repair estimating system that provides estimates for auto repairs. Wong discloses that the system has the ability to compare the cost for repairing a particular part to the cost of replacing the part to see which one is cheaper and to see which one is a better decision. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Li with a determination unit that determines whether or not the cost of a repair is greater than a predetermined fee, such as the cost of a replacement part, so that it can be seen

which is cheaper. If it costs more to repair something than to simply replace the part, one would surely want to have the part replaced, because the cost is cheaper and you get a totally new part. The output of this analysis would be the cost to repair versus the cost to replace, which satisfies the claimed limitation of the transmission unit being adapted to transmit information about a repair estimate and new products (the new part itself). With respect to the recitation that it is a ratio that is being compared, one of ordinary skill in the art would have recognized that one could do the comparison step of a repair to a replacement by either comparing the costs outright, or by using a ratio, where if the value of the ratio is less than 1, this indicates that the repair costs less than a replacement. This is just another mathematical way to compare the two numbers and is something that would have been obvious to one of ordinary skill in the art.

With respect to the recitations in section 1) and 2), the examiner has already addressed the transmission of the information about the repair fee estimate and the new products information. Not disclosed is the step of transmitting a method of recovering an article to be repaired and a type of method for delivery of the article as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not only provide the repair estimate and the information on how much a new part costs, but it would have been obvious to also provide other types of information to the customer, such as how one can go about having their equipment repaired (satisfies the "method for recovering an article to be repaired), when it may be done (method for delivering), etc... One of ordinary skill in the art would appreciate and understand that other types of information can also be displayed to the user. Applicant is attempting to

define over the prior art by the information that is being displayed to the customer and that is not being further used in any other method step. This seems to be a recitation that is directed to non-functional descriptive material due to the fact that the method for recovering or method for delivery is never really used any further in the claims. It is not proper to give patentably distinguishing weight to data that is just different from the prior art but that is also not even used in the claims in any further manipulative steps, although this data has been considered by the examiner to the extent that it is directed to non-functional descriptive material. The examiner has set forth an obviousness statement, but at the same time believes this language to be non-functional descriptive material that does not serve as a limitation.

With respect to section 3), not disclosed is that if the equipment is under warranty, window information is transmitted for displaying a type of method for recovering the article and a method for delivery for the repaired article, without transmitting the repair fee estimate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not send the repair estimate as part of the information when the equipment is covered under warranty. If it is covered under warranty, as far as the customer is concerned, the repair cost is information of little value because the cost is covered due to the fact it is under warranty. Also, when the equipment is covered under warranty, it would have been obvious to one of ordinary skill in the art at the time the invention was made to also provide other types of information to the customer, such as how one can go about having their equipment repaired (satisfies the "method for recovering an article to be repaired), when it may be

done (method for delivering), any special warranty information such as deductibles, etc... One of ordinary skill in the art would appreciate and understand that other types of information can also be displayed to the user. Applicant is attempting to define over the prior art by the information that is being displayed to the customer and not being further used in any other method step. This seems to be a recitation that is directed to non-functional descriptive material due to the fact that the method for recovering or method for delivery is never really used any further in the claims. It is not proper to give patentably distinguishing weight to data that is just different from the prior art but that is also not even used in the claims in any further manipulative steps. The examiner has set forth an obviousness statement, but at the same time believes this language to be non-functional descriptive material that does not serve as a limitation.

With respect to claiming that the equipment is a printer, it is widely known and the examiner takes "official notice" of the fact that equipment such as printers are provided with warranties. Having a warranty for a computer printer is very well known in the art as well as the fact that just about every product sold in the marketplace comes with some sort of warranty. Cars come with warranties. Computers come with warranties. Printers come with warranties. Modems come with warranties, etc.. This is nothing new. One of ordinary skill in the art would recognize and appreciate that the warranty method disclosed by Li can be applied to other types of products other than automobiles, with the same results being expected. Any product that has a warranty and that may need to be repaired can be used with the warranty system of Li. This would still allow the benefits of the system of Li to occur. This is just using the system



of Li for a different type of product other than automobiles. Any product that comes with a warranty can be used with the system of Li to check on warranty coverage and repair costs. Morrell discloses a printer that is able to display error codes to indicate errors to the user. The front panel 70 is used to display error codes, see column 3, line 45 to column 4, line 2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Li (combined with Wong as set forth by the examiner) for printers so that the benefits that the warranty system of Li provides can be realized with equipment such as printers. The results that the system of Li provides would be expected to be the same and the results are not dependent on the fact that Li discloses automobiles instead of printers. Also, as disclosed by Li, error codes are used and error codes are well known with the use of printers as is evidenced by Morrell. For one of ordinary skill in the art to take the system of Li (combined with Wong) and simply use it with another type of product, such as printers, is something that would have been obvious and is not seen as involving more than ordinary skill in the art. This is just using the system of Li (as modified) for a different type of product that also uses and has error codes. When the printer displays the failure code, this code can be transmitted to the management server for warranty processing.

For claims 62,65,68, Li inherently has a table specifying parts as claimed, this was addressed with respect to claim 61. Not disclosed is that the estimation unit looks up a *delivery date specifying table*. This is interpreted to be the act of determining whether or not a particular part is in stock or not, which indicates the delivery date to the customer. If the part is in stock, then the repair could potentially be done the same day,

whereas if the part needs to be ordered, it may take a day or more to obtain the necessary part, which would also depend on the part needed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Li determine the "delivery date" of a part by determining if the part is in stock or not. This satisfies what is claimed.

4. Applicant's arguments filed 11/5/07 have been fully considered but they are not persuasive.

Applicant has argued that the prior art does not disclose calculating a repair fee estimate by looking up a repair fee table on the basis of a failure code received from a user terminal and does not disclose a transmission unit adapted to transmit a failure code to a management server based on a failure code notified by a printer. The examiner disagrees. In Li, a code is used to look up the standardized hours for a particular job as identified by the code. This is then used to generate a repair estimate. This satisfies what is claimed. A code is used and data is looked up from a database to arrive at a repair estimate. Because the estimate for the repair is disclosed as being generated, and because a repair estimate inherently includes the cost of any parts needed to do the repair, it is inherent that there is a *determination* unit that determines the "price of the equipment" by looking it up in a database as claimed (in a party specifying table). This is a part of the repair estimate process. With respect to the receiving of the code from a printer, this is addressed in the current rejection of record. The use of the method of Li with a printer is seen as just using a different type of

product with Li, something that is considered to be obvious to one of ordinary skill in the art as set forth in the rejection. With respect to the user terminal and the transmission unit, Li discloses a terminal 80 that is used to send information to the management server as is claimed, which requires a transmission unit as is also addressed in the rejection of record. Applicant has not argued any other aspect of the 103 rejection and the various obviousness statements so they are deemed to be proper in the absence of a specific traversal.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/

Primary Examiner, Art Unit 3629